

## REMARKS

The Examiner is thanked for withdrawing the final rejection and entering the Amendment filed May 11, 2009.

In paragraph 6 of the Office Action, claims 1, 4, 23, 24 and 26 were rejected under 35 U.S.C. §103(a) as being unpatentable over Kazuo et al. (Kazuo) in view of Tiffany et al. (Tiffany).

Reconsideration of this rejection is requested.

The claimed invention is directed to a grease comprising a base grease and an additive where the base oil has a kinematic viscosity of from 20-200mm<sup>2</sup>/s at 40°C and is selected from poly- $\alpha$ -olefin oil, mineral oil and ether oil and the additive comprises bismuth compounds.

This novel composition is particularly useful for lubricating rolling bearings where the rolling bearing is used for rolling stock, building machines or electric motors for automotive applications where the claimed composition prevents flaking of the bearings, provides long term durability and heat resistance.

The Kazuo patent was applied as teaching a grease for press working where the grease comprised a mineral oil and bismuth oxide. Tiffany was applied as using a mineral oil having a specific viscosity at 40°C.

Kazuo discloses a grease which comprises sulfurized oil and fat, a phosphor-based extreme pressure agent and optionally mineral oil, with an activator which is a composite solid that includes bismuth oxide. From page 1 and the examples at pages 4 and 5 of Kazuo, it is apparent that the sulfurized oil and fat are essential components of the grease of Kazuo whereas the mineral oil is an optional component.

If one selects a mineral oil according to Tiffany with a specific viscosity within claim 1 of the present application, the product would always contain the sulfurized oil and fat that Kazuo disclosed as being essential components. It is

contrary to the teachings of Kazuo to make a grease without sulfurized oil and fat. The base oil of amended claim 1 is not the base oil of Kazuo which is a mixed oil. For these reasons, the grease defined by amended claim 1 and the claims that are dependent on amended claim 1 define unobvious subject matter and it is requested that this ground of rejection be withdrawn.

The Kazuo grease is directed to a lubricant for press working and not to a grease for a rolling bearing. In pressing, the lubricant is sprayed between the mold and the object to be pressed in order to assist in the pressing operation. Because the press operates at a temperature of at least 400°C, the properties of the lubricants are immediately affected. The lubricant is sprayed while the grease for a rolling bearing should be capable of continuously lubricating the rolling bearing for an extended time period and not for just one pressing cycle.

For these reasons, the amended claims define an invention that is not disclosed or suggested by the cited prior art. For these reasons, it is requested that this ground of rejection be withdrawn.

Claim 7 was rejected under 35 U.S.C. §103(A) as being unpatentable over Kazuo in view of Tiffany and Yamamoto et al. (Yamamoto).

Reconsideration is requested.

The Kazuo and Tiffany patents have been distinguished from the amended claims above. The Yamamoto patent teaches the addition of a lithium soap to a melamine-isocyanuric acid lubricant. This lubricant is completely different from the lubricants of Kazuo and Tiffany which do not use a melamine-isocyanuric acid adduct. In view of the distinctly different lubricant that is disclosed by Yamamoto, one skilled in the art would not be led to add a lithium soap to the grease defined by amended claim 1, based on the combined teachings of Kazuo, Tiffany and Yamamoto.

New claims 27-29 individually point out preferred inorganic bismuth compounds according to the invention. These

claims are patentable over the prior art for the same reasons,  
that claim 1 is patentable.

An early and favorable action is earnestly solicited.

Respectfully submitted,



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